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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/694,463

10/27/2003

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44323 7590 05/05/2008  
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EXAMINER

NGUYEN, TRINH T

ART UNIT

PAPER NUMBER

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MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/694,463	<b>Applicant(s)</b> DENICOLA, ROSEMARIE P.	
	<b>Examiner</b> Trinh T. Nguyen	<b>Art Unit</b> 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE dated 3/18/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination under 37 CFR 1.114 After Final Rejection***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/18/08 has been entered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-10, drawn to a plant root and bulb protection device, classified in class 47, subclass 78.
  - II. Claims 13 and 14, drawn to a method for protecting plant roots and bulbs, classified in class 47, subclass 76.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case \*\*\*.
4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement

will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. During a telephone conversation with Attorney Stein on 4/29/08 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13 and 14 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

#### ***Information Disclosure Statement***

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate

paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-5, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is noted that a claim which depends from a claim which "consists of" the recited elements cannot add an element (MPEP 2111.03); therefore, the added elements (i.e. a closure means and an anchor means) as claimed in claims 2-5 are improper.

Furthermore, the limitations as claimed in claims 2-5 are confusing since it is unclear if the Applicant is claiming "comprising" or "consisting of" language; therefore, it is not understood what is being claimed.

In claim 7: the phrases "diagonally shaped apertures" is confusing and unclear since Figure 2 of Applicant's invention shows that aperture (7) has an elongated ellipse shape.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergman (US 5060420) in view of Tesch (US 3644501).

For claim 1, Bergman discloses a protection device consisting of:

a continuous, non-composite, circumferentially closed tubular, substantially topologically plain, substantially non-rigid sheet liner (14) with an interior side, an exterior side, an integral, non-composite closed bottom end and open top end and a plurality of apertures wherein the apertures are positioned in a pattern which is regular and repeating (note that tubular sheet liner (14) is composed of porous material which has a plurality of apertures therein). Note that Bergman further discloses additional elements such as an identifier element (22), filament (16), bulb (12) and a depth marker (24); however, these additional elements do not influence/effect the overall operation/functioning of the protection device (10) what-so-ever.

Bergman disclose most of the claimed invention except for mentioning that the apertures are in an alternating anti-parallel orientation.

Tesch teaches that it is old and well known in the art to provide a plurality of apertures, in which the apertures are in an alternating anti-parallel orientation (see Figures 14 and 21), onto a flexible material so as to allow the flexible material to be freely permeable to air, steam and moisture (see lines 50-55 of col. 2). Because both Bergman and Tesch teach the concept of provide a plurality of apertures in a flexible material in an orientation so as to allow the flexible material to be freely permeable to air and/or moisture. It would have been obvious to one having ordinary skill in the art to

have modified the apertures of Bergman so as the apertures are in an alternating anti-parallel orientation, in a similar manner as taught in Tesch, since to do so would merely replace one old and well known apertures orientation (in this case, Bergman's apertures orientation) with another art equivalent old and well known apertures orientation (in this case, Tesch's apertures orientation) for allowing the flexible material to be freely permeable to air and/or moisture.

For claims 2, 4, and 5 (as best understood), Bergman as modified by Tesch (emphasis on Bergman) further discloses a closure means wherein the closure means is a tie (16).

For claim 6, Bergman as modified by Tesch (emphasis on Bergman) further discloses a plurality rows of apertures extending generally from the top end to the bottom end (see Figure 1).

For claim 7 (as best understood), Bergman as modified by Tesch (emphasis on Tesch) further discloses a plurality of diagonally shaped apertures (see Figures 14 and 21).

For claim 8 (as best understood), Bergman as modified by Tesch (emphasis on Tesch) further discloses alternating rows of diagonally shaped apertures wherein the diagonal shape is generally oriented from the top end to the bottom end in a left to right direction in a first row and wherein the diagonal shape is generally oriented from the top end to the bottom end in a right to left direction in a second row (see Figures 14 and 21).



For claim 9, Bergman as modified by Tesch (emphasis on Bergman) further discloses the apertures (note that tubular sheet liner (14) is composed of porous material which has a plurality of apertures therein) are capable of preventing passage of vermin from the exterior side to the interior side and wherein the aperture is capable of permitting passage of water from the exterior side to the interior side.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Beers (US 1464801).

As described above, the references as applied to claim 1 above disclose most of the claimed invention except for an anchor means.

Beers teaches a concept of using post member (3) as an anchor means to secure member (A) to the ground. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of the references as applied to claim 1 above so as to include the use of an anchor means, in a similar manner as taught in Beers, since to do so would allow the user to anchor the device in a more stable position and/or location and thus prevent the device from tipping over.

12. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Stubbmann (US 3415012).

As described above, the references as applied to claim 1 above disclose most of the claimed invention except for the use of a specific material such as plastic to make the tubular sheet liner.

Stubbmann teaches a tubular sheet liner (12) for protecting bulb wherein the liner is made out of plastic (see lines 54-60 of col. 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the tubular sheet liner of the references as applied to claim 1 above so as to make out of plastic, in a similar manner as taught in Stubbmann, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use that is not react when exposed to soil constituents, nutrients or water.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-10, 13, and 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T. Nguyen whose telephone number is (571) 272-6906. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on (571) 272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Trinh T Nguyen/  
Primary Examiner, Art Unit 3644  
5/1/08